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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 09/588,037  | 06/05/2000  | J. Gregory Stout     | A-68146/MAK/LM          | 8559             |
| 30636   | 7590        | 12/13/2004           | EXAMINER                |                  |
| FAY KAPLUN & MARCIN, LLP<br>150 BROADWAY, SUITE 702<br>NEW YORK, NY 10038 |             |                      | KALINOWSKI, ALEXANDER G |                  |
|   |             |                      | ART UNIT                | PAPER NUMBER     |
|   |             |                      | 3626                    |                  |

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |   |
|------------------------------|------------------------|---|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b>                     |
|                              | 09/588,037             | STOUT, J. GREGORY<br><i>[Signature]</i> |
|                              | <b>Examiner</b>        | <b>Art Unit</b>                         |
|                              | Alexander Kalinowski   | 3626                                    |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 November 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 30-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 30-49 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claims 30-49 are presented for examination. Applicant filed a request for continued examination on 11/29/04. In addition Applicant filed a preliminary amendment canceling claims 1-29 and adding new claims 30-49. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/29/2004 has been entered. In response to the request for continued examination on 11/29/04 and preliminary amendment, the Examiner withdraws the grounds of rejection of claims 1-29. New grounds of rejection of claims 30-49 are established in the instant office action as set forth in detail below.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 30-36 and 46-49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer system) within the recited steps of the claimed method of processing consumer transactions. The recited steps constitute an idea on how to create and manage a method of identifying and presenting offers based on consumer transactions.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed method recites steps for identifying and presenting offers based on consumer transactions.

2. Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 30-36 and 46-49 are deemed to be directed to non statutory subject .

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 30-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Pat. No. 6,055,573, Gardenswartz et al. (hereinafter Gardenswartz).

As to claim 30, 37-41 and 43-47, Gardenswartz discloses A method, comprising: identifying a consumer at a first merchant location where the consumer presents an instrument during a processing of a first transaction at the first merchant, wherein the consumer is identified with a unique identification (col. 5, lines 44-60); presenting an offer to the consumer based on information from the first transaction (col. 10, lines 23-34); receiving an indication of acceptance of the offer from the consumer (col. 16, lines 36-55); associating the indication of acceptance with the unique identification of the consumer (col. 16, lines 56-65);

identifying the consumer at a second merchant location where the consumer presents the instrument during the processing of a second transaction (col. 17, lines 3-44 and col. 19, lines 17-48); and

retrieving the offer based on the identification of the consumer at the second merchant location, wherein the offer is applied to the second transaction (col. 17, lines 3-44 and col. 19, lines 17-48).

As to claim 31 and 42, Gardenswartz discloses The method of claim 30, wherein the instrument is one of a credit card, a debit card and a customer loyalty card (col. 5, lines 44-60).

As to claim 32 and 48, Gardenswartz discloses The method of claim 30, wherein the offer is a discount on merchandise (col. 14, lines 56-60).

As to claim 33, Gardenswartz discloses The method of claim 30, wherein the second merchant location is independent from the first merchant location (see Fig. 1).

As to claims 34 and 49, Gardenswartz discloses The method of claim 30, wherein the information from the first transaction includes an identification of a purchased product (see Fig. 2).

As to claim 35, Gardenswartz discloses The method of claim 30, further comprising the step of-.

disassociating the indication of acceptance with the unique identification when the consumer completes the second transaction (col. 20, lines 25-30).

As to claim 36, Gardenswartz discloses The method of claim 30, further comprising the step of

disassociating the indication of acceptance with the unique identification when the second transaction is incomplete after expiration of a predetermined period of time (col. 16, lines 50-55).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 30-49 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. "Growing firm helps Internet marketers" discloses universal reward currency.
- b. "Beenz means money" discloses Internet incentives.
- c. "Points for loyalty" discloses universal rewards currency.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

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If any attempt to reached the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Primary Examiner

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12/3/2004